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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------|-------------|----------------------|---------------------|------------------|
| 09/734,988 | 12/11/2000 | David Resnick | 39048.21 | 6113 |
| 27683 | 7590 | 09/11/2009 | EXAMINER | |
| HAYNES AND BOONE, LLP | | | MILEF, ELDA G | |
| IP Section | | | ART UNIT | |
| 2323 Victory Avenue | | | PAPER NUMBER | |
| Suite 700 | | | 3692 | |
| Dallas, TX 75219 | | | MAIL DATE | |
| | | | DELIVERY MODE | |
| | | | 09/11/2009 | |
| | | | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/734,988 | Applicant(s) RESNICK ET AL. | |
| | Examiner Elda Milef | Art Unit 3692 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 July 2009.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 35-47, 49, 51-53, 56, 57 and 59-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 35-47, 49, 51-53, 56, 57 and 59-66 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| <ul style="list-style-type: none"> 1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____. | <ul style="list-style-type: none"> 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application 6) <input type="checkbox"/> Other: _____. |
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DETAILED ACTION

Status of the Claims

1. This office action is in response to the amendments submitted by the applicants on 7/27/2009.

- Claims 1-34, 48, 50, 54-55, 58 are cancelled.
- Claims 35, 39-47, 49, 51-53, 56-57, 59-65 are amended.
- Claim 66 is new.
- Claims 35-47, 49, 51-53, 56-57, 59-66 are pending in the application.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/27/09 has been entered.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Regarding claims 35-40, the applicant claims an

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end-user interface; a service account identifier; a service account. There is lack of antecedent basis these terms.

While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification, *Ex parte Kotler*, 1901 C.D. 62, 95 O.G. 2684 (Comm'r Pat. 1901). See 37 CFR 1.75, MPEP § 608.01(i) and § 1302.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 35-47, 49, 51-53, 56-57, 59-66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It appears that the claims are replete with new matter, for example, “an end-user interface communicably coupled to the payment processor system”, “service account.” Regarding the “end-user account”, the specification refers to a card user visiting a point

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of sale location where a point of sale terminal is located and a card user making a payment to the merchant (Specification, page 7 line 24 to page 8), and a “customer interface” fig. 1 item 100, the customer defined by the applicant as a provider of goods and services such as a wireless carrier. Specific support for an end-user (defined as a cardholder) accessing an end-user interface could not be found. Furthermore, the applicant discloses a POS terminal transmits an authorization request into the financial network. No support could be found for an end-user interface communicably coupled to the payment processor system.

Claim 35 recites receiving from an end-user accessing the end-user interface an intermediary account identifier...and a service account identifier... There is not support for this in the specification.

The applicant defines the following:

end-user = cardholder pg. 7 lines 10-23; pg. 11 line 30;

customer= provider of goods or services; vendor pg. 7 lines 8-17; pg. 11 line 29;

User account = end-user account (maintained by vendor such as wireless carrier)-p 7 line 10;

User account identifier = intermediary account =physical card p. 7 line 29 to p. 8 lines 3-5;

The applicant further refers to the cardholder making a payment to a merchant and presenting a user account identifier which refers to the intermediary account maintained at the payment processor 40. The card user can present the intermediary account number by providing a physical card. pg. 7 line 28 to pg. 8 line 6.

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The load notification signal identifies the end-user account that corresponds to the intermediary account number presented by the card user at the POS terminal. P. 9 lines 16-20. There is no mention in the specification of the end-user (cardholder) entering a service account identifier in addition to the intermediary account identifier.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 35,36, 38-42, 49, 52-53, 56-57, 59-61, 63-64, 66 are rejected under 35 U.S.C. 102(e) as being anticipated by Dorf (U.S. Patent No. 6,000,608).

In view of the 112 paragraph rejections above, the Examiner is interpreting end-user interface as a point of sale terminal; service account as the wireless carrier account.

Re claim 35: Dorf discloses:

a payment processor system that maintains a database (Processing hub 103, and databases 205-207; Fig. 2;

an end user interface communicably coupled to the payment processor system, wherein the user interface is configured to:

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receive, from an end-user accessing the end-user interface, an intermediary account identifier that identifies a stored value account (The clerk swipes prepaid phone card through POS device col. 5 lines 32-34; card includes an identification number read from the card's magnetic strip col. 6 lines 9-11); maintained by the payment processor system and a service account identifier that identifies a service account maintained by a service provider system that is separate from the payment processor system, and store an association between the intermediary account identifier and the service account identifier in the database maintained by the payment processor system (the processing hub recognizes the identification number of the card as being associated with a particular prepaid phone card issuer-col. 7 lines 3-5);

store an association between the intermediary account identifier and the service account identifier in the database maintained by the payment processor ((the processing hub recognizes the identification number of the card as being associated with a particular prepaid phone card issuer-col. 7 lines 3-5);

a terminal located at a point-of-sale, wherein the terminal is configured to receive a payment and the intermediary account identifier from a payor (The clerk swipes prepaid phone card through POS device col. 5 lines 32-34; card includes an identification number read from the card's magnetic strip col. 6 lines 9-11), and wherein the terminal is operable to exchange electronic messages with a financial network that is communicably coupled to the payment processor system(Fig. 1 and 2 and related text);

a crediting device in communication with the payment processor system, wherein the crediting device is configured to credit the stored-value account identified by the

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intermediary account identifier in response to the payment (issuer hub receives the data from the processing hub; issuer hub activates record in the phone card database having the same identification number as the card; the value field in the record is then increased)-col. 7 lines 15-18;

an interface device in communication with the payment processor system and the service provider system, wherein the interface device is configured to send a message to the service provider system indicating a credit to the service account identified by the service account identifier associated with the intermediary account identifier. Dorf disclose the processing hub forwarding the card identification number to the issuer hub; activate the record in the database and increasing the record associated with the card number by the purchased amount; the issuer returning an authorization number which travels along the same path to the origination POS device. Col. 7 lines 9-22; Dorf further disclose Processing Hub technical details including the software program of the system written for database management and user interface; on-line transactions may be viewed by the system operators using the Foxpro™ interface... External communications nodes provide the necessary interface requirements of physical connectivity, protocol, message transmission, message validation, and message processing.-see col. 11 lines 15-31. Therefore, there is an interface connecting the issuer hub 204 and processing hub 103 as disclosed in Fig.2

Re claim 36: Dorf discloses a system and method:

wherein the terminal located at the point-of-sale comprises an automated teller machine (ATM)-see col. 1.

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Re claims 38 and 39: Dorf discloses wherein the financial network comprises a card association network, and the acquiring processor configured to communicate messages between the financial network and a plurality of the terminals.-see col. 1 lines 19-23, col. 4 lines 47-67.

Claims 40, 41 and 66 have similar limitations found in claim 35 above, and therefore are rejected by the same art and rationale as claim 35 above.

Re claim 42: Dorf discloses:

wherein the payment interface is configured to receive data from the terminal located at the point of sale via a merchant hub that is communicably coupled to the terminal and the payment interface -see fig.2 "Retailer E" and related text.

Re claim 49: Dorf disclose issuing a card to the end-user that includes the intermediary account identifier. -see col. 7 lines 2-20.

Re claims 52, 53 and 57: Dorf discloses wherein the end-user's account identifier has an account number corresponding to a valid credit card account number and can be presented by payor at the POS terminal to purchase goods and services.- see col. 4 lines 36-67 and col. 1.

Re claim 56: Dorf disclose the terminal is coupled to the internet and the POS includes a website ("more particularly to a multifunction card system that can be accessed by a variety of standard point-of-sale devices, by phone, by fax, or over the Internet.") Col. 1 lines 4-8.

Re claims 59-61: Dorf discloses:

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wherein receiving a payment from the end-user at the point of sale includes receiving the payment:

in the form of cash-see col.5;

as a debit card transaction-see cols. 5,7,8;

as a credit card transaction-see col.8 lines 3-6;

Re claim 63: Dorf discloses a brick-and-mortar retail merchant site.-see col. 5.

Re claim 64: Dorf discloses a system and method wherein the terminal located at the point-of-sale comprises an automated teller machine (ATM)-see col. 1;

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 37, 43, 45-47, 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf in view of Muehlberger (U.S. Patent No. 5,696,908).

Re claim 37: Although Dorf discloses a system and method, (“In order to achieve the desired functionality, the system 108 uses existing banking networks in a unique and novel way to gain access to virtually all existing retail point-of-sale (POS) devices 105...”)-see col. 4 lines 25-35, Dorf does not specifically disclose wherein the point-of-sale terminal comprises a vending machine. Muehlberger however, teaches (“Telephone debit cards are automatically vended through a microprocessor controlled

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vending machine –see Abstract, and col.3 It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dorf to include that the point-of-sale terminal be a vending machine as taught by Muehlberger in order to provide the customer with convenience of purchasing a pre-paid card at multiple locations.

Re claims 43, 45, 47 : Dorf discloses a system and method designating an intermediary bank account and collecting an amount of money equal to the payment amount, subject to adjustment, from the point-of-sale merchant's bank account into the intermediary bank account.–see fig. 2 and col. 6 lines 32-51. Dorf does not specifically disclose electronic funds transfer and wherein said collecting step is effecting via the ACH. Muehlberger however, teaches using electronic funds transfer and ACH in col. 3 lines 21-24. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dorf to include electronic funds transfer as taught by Muehlberger in order to for the customer to be able to use the telephone card immediately.

Re claim 46: Dorf discloses wherein the telecommunications vendor is a prepaid platform operator. –see col. 5 lines 19-20.

Re claim 62: Although Dorf discloses a system and method, (“In order to achieve the desired functionality, the system 108 uses existing banking networks in a unique and novel way to gain access to virtually all existing retail point-of-sale (POS) devices 105...”)-see col. 4 lines 25-35, Dorf does not specifically disclose wherein the point-of-sale terminal comprises a vending machine. Muehlberger however, teaches

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("Telephone debit cards are automatically vended through a microprocessor controlled vending machine –see Abstract, and col.3. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dorf to include that the point-of-sale terminal be a vending machine as taught by Muehlberger in order to provide the customer with convenience of purchasing a pre-paid card at multiple locations.

7. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf in view of Muehlberger as applied to claim 43 above further in view of Risafi (US Patent No. 6,473,500).

Re claim 44: Dorf and Muehlberger do not specifically disclose said transfer of money equal to payment is carried out in a batch mode on a daily basis. Risafi however, teaches ("In addition to activating a card using these two methods, other functions can be performed on either an individual or a batch basis. The PIN can be changed, the card account can be reloaded, either by the card user or on the card user's behalf, purchases can be made, and the account can be closed.")-see col. 9 lines 19-23, col. 12 lines 52-67, col. 14 lines 31-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dorf and Muehlberger to include batch processing as was done by Risafi in order to process many cards at a time.

8. Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf in view of Carson (U.S. Patent No. 6,028,920).

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Re claim 51: Although Dorf discloses (“The multifunction card system further comprises at least one phone card having a unique identification number encoded on it...”)-see col. 3 lines 28-41, Dorf do not specifically disclose the account is a cellular phone account. Carson however, teaches a pre-paid phone card system wherein the telephone service provider associated with the pre-paid telephone card is a wireless telephone service provider. –see col. 16 lines 40-49. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dorf to include a pre-paid telephone card to be used with wireless phone service as taught by Carson in order to provide the customer with a means of pre-paying for wireless telephone service.

9. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf in view of Risafi (US Patent No. 6,473,500).

Re claim 65: Dorf does not specifically disclose electronically communicating data includes interaction with an IVR system via telecommunications. Risafi however, discloses a pre-paid card system and method using voice recognition.-see col.7 lines 3-8. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dorf to include a voice recognition system in order to connect to a network.

Response to Arguments

10. Applicant's arguments with respect to claims 35-47, 49, 51-53, 56-57, 59-66 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday -Friday 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571)272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Elda Milef
Examiner
Art Unit 3692

/Kambiz Abdi/
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